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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,654

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Charlotte Pham

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7452

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01/05/2010

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EXAMINER

MARTINEZ, BRITTANY M

ART UNIT

PAPER NUMBER

1793

MAIL DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/553,654	<b>Applicant(s)</b> PHAM ET AL.	
	<b>Examiner</b> BRITTANY M. MARTINEZ	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 September 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Status of Application*

Applicants' arguments/remarks and amendments filed September 1, 2009, have been carefully considered. **Claims 1-20** are pending, with **Claims 1, 3, 10, 18 and 19** amended. **Claims 1-20** have been examined in the instant application.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. **Claims 3, 10 and 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.
3. With regard to **Claims 3, 10 and 19**, the portion of the claims that reads "at least one of... or" uses improper Markush/alternative format. See MPEP § 2173.05(h).

### *Claim Rejections - 35 USC § 103*

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. **Claims 1-2, 4, 6, 8, and 15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmi (DE 4420294), as applied in the prior Office action.

Art Unit: 1793

6. **Claims 1-2, 4, 6, 8 and 16-17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cortellini (US 5,876,584), as applied in the prior Office action.

7. **Claims 1-14 and 16-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gadkaree et al. (US 6,555,031 B2) in view of Cortellini (US 5,876,584), as applied in the prior Office action.

8. **Claims 1-6, 8-15 and 18-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Gadkaree et al. (US 6,555,031 B2) in view of Wilhelmi (DE 4420294), as applied in the prior Office action.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 1793

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1-4, 6-8, 10-11 and 13-20** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1-2, 8-10 and 14-20 of copending Application No. 11/569103, as applied in the prior Office action.

### ***Response to Amendment***

Applicants' amendments filed September 1, 2009, with respect to the Claims have been fully considered and are accepted. The Claim objections of **Claims 1, 3, 4, 8, 10, 11, 18 and 19** and the 35 U.S.C. 112, second paragraph, rejections of **Claims 1 and 18** in the previous Office action are withdrawn. It is noted that Applicants' amendments to **Claims 3, 10 and 19** have necessitated new 35 U.S.C. 112, second paragraph, rejections, as can be seen above.

### ***Response to Arguments***

10. Applicants' arguments filed September 1, 2009, have been fully considered but they are not persuasive.

11. Applicants' arguments with regard to Wilhelmi (Applicants' Response, 9/1/09, p. 5-6) are not convincing. Applicants' arguments regarding the conventional preparation of ceramic materials are not supported by any evidence on record, and the composition is held to be obvious, when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim

Art Unit: 1793

although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983), and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir.1985).

See also MPEP 2113.

12. Applicants' arguments with regard to the aluminum smelting furnace are not convincing. First, **Claim 1**, is a product by process claim and the aluminum smelting furnace is merely an intended use. **Claim 1** does not require an aluminum smelting furnace. In any event, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

13. Applicants' arguments that Wilhelmi teaches away from using SiC bricks because the bricks contain at least 50% by weight alumina are not convincing. The instant application claims between 80 and 95% inclusions, wherein at least a portion of the inclusions comprise alumina (**Claims 2 and 3**).

14. Applicants' arguments with regard to Cortellini (Applicants' Response, 9/1/09, p. 6-7) are not convincing. Applicants' arguments regarding the preparation of the material of Cortellini are not convincing because the composition is held to be obvious, when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983), and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir.1985). See also MPEP 2113.

Applicants' argument that the product of the instant application does not comprise a

Art Unit: 1793

binder is not convincing since the instant claims do not preclude the use of a binder.

Further, Applicants' argument that ceramic SiC is usually alpha-SiC is not supported by any evidence on record. Still further, the instant application does not preclude the presence of alpha-SiC.

15. Applicants' arguments regarding the instant invention not using an inert gas atmosphere or vacuum are not germane to the breadth of the instant Claims.

16. Applicants' arguments regarding unexpected results are not supported by any evidence on record.

17. Applicants' arguments with regard to Gadkaree (Applicants' Response, 9/1/09, p. 7-8) are not convincing. Applicants' arguments regarding the preparation process of Gadkaree are not supported by any evidence on record, and the composition is held to be obvious, when the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983), and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir.1985). See also MPEP 2113.

### ***Conclusion***

18. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRITTANY M. MARTINEZ whose telephone number is (571) 270-3586. The examiner can normally be reached on Monday-Friday 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1793

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wayne Langel/  
Primary Examiner, Art Unit 1793

BMM  
/Brittany M Martinez/  
Examiner, Art Unit 1793